

4



PATENT
Attorney Docket No. 7744.0061
Customer No.: 22,852

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Michael A. EKHAUS et al.)
Serial No.: 09/887,528) Group Art Unit: 2163
Filed: June 25, 2001) Examiner: Unknown
For: METHOD AND SYSTEM FOR HIGH)
PERFORMANCE MODEL-BASED)
PERSONALIZATION)

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

**PETITION FOR CONSIDERATION OF DECLARATION UNDER
37 C.F.R. § 1.47(a) ON BEHALF OF A NONSIGNING INVENTOR**

Pursuant to 37 C.F.R. § 1.47(a), the undersigned petitions the Commissioner for inventors Robert Driskill and Filip Mulier of the above-identified application to make the application for a U.S. Patent on behalf of nonsigning joint inventor Michael A. Ekhaus. Although Mr. Ekhaus was presented with a copy of the above-identified application, including a copy of the figures, and was presented with a copy of a Declaration for the above-identified application, Mr. Ekhaus has refused to join in the application by refusing to execute the Declaration in a form that would comply with 35 U.S.C. § 115 and 37 C.F.R. § 1.63(b)(2).

M.P.E.P. § 409.03(a)(B) requires that the application be accompanied by proof that the nonsigning inventor refuses to execute the application papers. According to

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

03/21/2002 CV0111

00000022 09887528

06 FC:122

130.00 OP

Application No. 09/887,528

M.P.E.P. § 409.03(d), the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person to whom the refusal was made, documentary evidence to support the facts, if any, should be submitted, and the nonsigning inventor's reasons, if any, for refusing to sign the Declaration. Accordingly, Applicants submit (i) a statement of facts describing the presentation of the application papers and the subsequent refusal to join by joint inventor Michael A. Ekhaus correlated with documentary evidence to support the statement of facts and (ii) the reasons provided by joint inventor Michael A. Ekhaus for refusing to sign the Declaration. Furthermore, submitted with this petition is the required fee of \$130.00 as set forth in 37 C.F.R. § 1.17(h), Declarations signed by the available inventors in accordance with M.P.E.P. § 409.03(a)(A), and the last known address for each nonsigning inventor in accordance with M.P.E.P. §§ 409.03(a)(C) and 409.03(e).

STATEMENT OF FACTS CORRELATED WITH DOCUMENTARY EVIDENCE

I. On September 27, 2001, the undersigned sent a copy of the above-identified application including figures and drawings, a copy of a Declaration to all of the joint inventors via Federal Express. (See Exhibits A, B, & C: copies of the September 27, 2001 cover letters to Michael A. Ekhaus, Robert Driskill, and Filip Mulier; and Exhibit D: a copy of the September 27, 2001 Declaration sent to all of the joint inventors.)

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Application No. 09/887,528

II. The copy of the application including the figures and the drawings mailed on September 27, 2002 to Mr. Ekhaus was sent to his last known address (indicated on Exhibit A):

Mr. Michael A. Ekhaus
315 Washington Avenue
Hopkins, MN 55343

III. On October 15, 2001, the undersigned received a telephone call from attorney William A. Cumming of Moss & Barnett. Mr. Cumming stated to the undersigned that he was acting as attorney for joint inventor Mr. Ekhaus. Mr. Cumming stated that he wanted to advise Mr. Ekhaus on the September 27, 2001 application papers sent to Mr. Ekhaus by the undersigned but that he (Mr. Cumming) was concerned about the potential disclosure of Net Perceptions, Inc. (hereinafter "the Assignee") Proprietary Information. Mr. Cumming requested the Assignee's approval of his and Mr. Ekhaus' discussions regarding the September 27, 2001 application papers. The undersigned notes that all future requests and communications from the undersigned, on behalf of the Assignee, to joint inventor Mr. Ekhaus were directed to those identified as counsel for Mr. Ekhaus.

IV. On October 24, 2001, after promptly consulting with the Assignee, the undersigned provided authorization on behalf of the Assignee to Mr. Cumming to have discussions with Mr. Ekhaus regarding the application papers taking into account the potential disclosure of Assignee Proprietary Information. In addition, the undersigned requested Mr. Ekhaus to provide the undersigned with references and information Mr. Ekhaus considers material to the examination of the application. (See Exhibit E: a copy of the October 24, 2001 letter sent by facsimile and

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Application No. 09/887,528

mail to Mr. Cumming as counsel for Mr. Ekhaus.)

V. On December 21, 2001, after it came to the undersigned's attention that the copies of the Declaration sent on September 27, 2001 (Exhibit D) did not include a reference to U.S. Provisional Application No. 60/213,528, a new version of the Declaration was sent to joint inventors Robert Driskill and Filip Mulier, and also to Mr. Cumming as counsel for Mr. Ekhaus. (See Exhibits F, G, & H: copies of the December 21, 2001 cover letters sent to Robert Driskill, Filip Mulier, and Mr. Cumming as counsel for Mr. Ekhaus; and Exhibit I: a copy of the December 21, 2001 Declaration.)

VI. On January 14, 2002, the undersigned received an executed version of the December 21, 2001 Declaration from joint inventor Filip Mulier. The Declaration was executed on January 8, 2002 and includes a blank signature block for joint inventor Michael A. Ekhaus. (See Exhibit J: copy of executed Declaration from joint inventor Filip Mulier.)

VII. On January 17, 2002, the undersigned received via facsimile an executed version of the December 21, 2001 Declaration from joint inventor Robert Driskill. The Declaration was executed on December 23, 2001 and includes a blank signature block for joint inventor Michael A. Ekhaus. The original of the executed Declaration was later received by regular mail. (See Exhibit K: a copy of the original executed Declaration from joint inventor Robert Driskill).

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Application No. 09/887,528

VIII. Between October 24, 2001 and January 22, 2002, the undersigned, not having heard from Mr. Cumming, contacted Mr. Cumming by telephone. Subsequent to December 21, 2001, the undersigned learned from Mr. Cumming that attorney Glen E. Schumann, also of Moss & Barnett and indicated as a registered patent attorney, was advising joint inventor Mr. Ekhaus on the September 27, 2001 application papers sent to Mr. Ekhaus. During this time period (between December 21, 2001 and January 22, 2002), the undersigned left a voice mail message for Mr. Schumann in order to inquire about the status of his review with Mr. Ekhaus.

IX. On January 22, 2002 the undersigned had the first telephone conversation with Mr. Schumann. Mr. Schumann indicated that he was in the process of reviewing the materials with Mr. Ekhaus. To ensure that Mr. Schumann had the latest version of the Declaration, the undersigned sent by e-mail to Mr. Schumann a copy of the Declaration sent on December 21, 2001 to Mr. Cumming. (See Exhibit L: a copy of the January 22, 2002 e-mail to Mr. Schumann as counsel for Mr. Ekhaus. The attachment sent with this e-mail was an electronic version of Exhibit I.) The undersigned notes that all future communications and requests by the undersigned on behalf of the Assignee to Mr. Ekhaus were directed to Mr. Schumann.

X. On February 6, 2002, not having heard from Mr. Schumann, the undersigned left a voice mail message for Mr. Schumann to inquire as to the status of his review of the application papers with Mr. Ekhaus.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Application No. 09/887,528

XI. On February 14, 2002, still not having heard from Mr. Schumann, the undersigned called Mr. Schumann. Mr. Schumann indicated that he was still reviewing the materials and that he would contact the undersigned by February 15, 2002 to provide an update on the status of his discussions with Mr. Ekhaus.

XII. On February 18, 2002, the undersigned received a voice mail message from Cynthia Griffin, who identified herself as someone that works with Mr. Schumann at Moss & Barnett. Ms. Griffin indicated that Mr. Schumann asked her to call the undersigned in order to indicate that Mr. Schumann was not able to get to the material regarding Mr. Ekhaus on February 15, 2002 and that Mr. Schumann was away until February 21, 2002. Ms. Griffin further indicated to the undersigned that Mr. Schumann would contact the undersigned by February 21, 2002.

XIII. On March 1, 2002, not having heard from Mr. Schumann, the undersigned left a voice mail message for Mr. Schumann indicating that the undersigned desired to resolve any issue regarding the Declaration by the week of March 4-8, 2002.

XIV. On March 7, 2002 at approximately 4 p.m. EST, the undersigned received the first written communication on behalf of joint inventor Mr. Ekhaus in response to the September 27, 2001 application papers. The communication consisted of a facsimile from Mr. Schumann with a revised "Declaration" in two versions: one version with markings to show the changes made and a second version without markings. The communication from Mr. Schumann also expressed the reasons for the alterations to the "Declaration" (reproduced below, emphasis added):

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Application No. 09/887,528

Please understand that my client has at least two essential concerns. First, Mr. Ekhaus believes that nothing he has done is particularly novel and, therefore, he is concerned that there may be no "invention." Secondly, Mr. Ekhaus was not able to review the provisional and final applications to his complete satisfaction prior to his filing of the same [on June 25, 2001]. As a consequence, Mr. Ekhaus is concerned about making representations about applications containing information largely drafted by another and not fully pre-approved by Mr. Ekhaus.

(See Exhibit M: March 7, 2002 facsimile from Mr. Schumann on behalf of Mr. Ekhaus.)

XV. On the morning of March 8, 2002, the undersigned telephoned Mr. Schumann to discuss Mr. Schumann's March 7, 2002 facsimile. The undersigned indicated to Mr. Schumann that Mr. Schumann's altered Declaration was not in compliance with the Statute (35 U.S.C.) and the Rules (37 C.F.R.). The undersigned specifically indicated to Mr. Schumann that language stating that Mr. Ekhaus believes himself to be an "original, first, and a joint inventor" and deleted by Mr. Schumann and Mr. Ekhaus is required in the Declaration in order for the Declaration to be acceptable. Furthermore, the undersigned specifically indicated to Mr. Schumann that language stating that Mr. Ekhaus has "reviewed and understand[s] the contents" of the application "including the claims," again deleted by Mr. Schumann and Mr. Ekhaus, is also required in the Declaration in order for the Declaration to be acceptable. The undersigned indicated to Mr. Schumann that if Mr. Ekhaus refused to execute a Declaration in compliance with the Statute and the Rules, that the Assignee would proceed in accordance with 37 CFR 1.47. Mr. Schumann indicated to the undersigned that if the undersigned were to propose changes to the language in the Declaration that would satisfy his client (Mr. Ekhaus) as well as the Statute and the Rules, he would review it with Mr. Ekhaus. At approximately 4:40 p.m. EST, the undersigned sent by

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Application No. 09/887,528

e-mail to Mr. Schumann a proposed Declaration that the undersigned felt would be compatible with the Statute, the Rules, and Mr. Ekhaus' expressed concerns. The undersigned also left a voice mail message for Mr. Schumann indicating that proposed materials were being sent to him by e-mail. (See Exhibit N: a copy of the March 8, 2002 e-mail to Mr. Schumann as counsel for Mr. Ekhaus; and Exhibit O: a copy of the proposed Declaration sent with the March 8, 2002 e-mail with markings to show the proposed changes.)

XVI. On March 12, 2002, not having heard from Mr. Schumann by 4:30 p.m., the undersigned placed a call to Mr. Schumann in order to determine the status of Mr. Schumann's and Mr. Ekhaus' review of the proposed Declaration and Assignment. Mr. Schumann apologized for not contacting the undersigned earlier and indicated that he had prepared a facsimile to send to the undersigned that apparently had not yet been sent. Mr. Schumann reiterated the view recited above in his March 7, 2002 facsimile on behalf of Mr. Ekhaus. Mr. Schumann indicated that a facsimile would be sent to the undersigned shortly. A facsimile was received from Mr. Schumann at approximately 5 p.m. EST. The March 12, 2002 facsimile from Mr. Schumann elaborated further upon the reasons for the alterations to the Declaration (reproduced below, emphasis added):

I have reviewed your proposed Declaration and Assignment with Mr. Ekhaus. We have adopted some of your proposed changes to the Assignment, and we are prepared to deliver an executed Assignment to you in the form attached. However, because Mr. Ekhaus firmly believes that he may not be the "first, original inventor" of anything contained within the application, and because Mr. Ekhaus has not had the opportunity to fully review the application to the decree [sic] that makes him comfortable with what is contained therein, Mr. Ekhaus is only willing to sign the Declaration which we recently proposed for signature, with the addition of your language related to the existence of an

Application No. 09/887,528

invention. (See proposed copy attached.)

If these documents are sufficient for your purposes, Mr. Ekhaus will promptly execute them and we will forward them to you for immediate delivery. If these documents are not acceptable, please accept this letter as confirmation on behalf of our client that he believes he is not in a position to execute the Assignment and Declaration as you have proposed.

(See Exhibit P: a copy of the March 12, 2002 facsimile from Mr. Schumann on behalf of Mr. Ekhaus.)

XVII. On March 13, 2002, the undersigned sent by facsimile and by e-mail to Mr. Schumann a request that Mr. Ekhaus execute the version of the "Declaration" lately proposed by Mr. Schumann. The undersigned further informed Mr. Schumann as counsel for Mr. Ekhaus that the Assignee would proceed in accordance with 37 CFR 1.47 on the basis of Mr. Schumann's March 12, 2002 facsimile. The undersigned again requested Mr. Ekhaus to provide the undersigned with references and information Mr. Ekhaus considers material to the examination of the application. (See Exhibits Q & R: copies of the March 13, 2002 facsimile and e-mail to Mr. Schumann as counsel for Mr. Ekhaus.)

XVIII. On March 15, 2002, in reply to the undersigned's March 13, 2002 e-mail and facsimile, the undersigned received by facsimile from Mr. Schumann an executed version of the "Declaration" that Mr. Ekhaus approved of. Mr. Schumann further indicated that joint inventor Mr. Ekhaus intended to submit a prior art disclosure, "however, it obviously will take a little time for him [Mr. Ekhaus] to pull this together." (See Exhibit S: a copy of the March 15, 2002 facsimile from Mr. Schumann on behalf of Mr. Ekhaus.)

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Application No. 09/887,528

REASONS PROVIDED BY JOINT INVENTOR MR. EKHAUS' FOR REFUSING TO JOIN

As alleged by Mr. Schumann, a registered patent attorney acting as counsel for joint inventor Mr. Ekhaus, and reproduced as Exhibit P, joint inventor Mr. Ekhaus apparently believes he cannot represent himself as an "original, first" joint inventor where such language is required in a Declaration under 35 U.S.C § 115. (See Exhibit P: a copy of the March 12, 2002 facsimile from Mr. Schumann on behalf of Mr. Ekhaus stating the reasons for altering the proposed Declaration.)

Furthermore, (i) despite the fact that the documentary evidence indicates that a copy of the application and figures was sent to Mr. Ekhaus over five months ago to his last known address, (ii) despite the fact that the documentary evidence indicates that authority to review the contents of the application papers was promptly granted over four months by the Assignee to Mr. Ekhaus' chosen counsel, (iii) despite Mr. Ekhaus' views on the alleged lack of novelty of his contribution to the above-identified application expressed by Mr. Schumann as late as March 7, 2002 (see Exhibit M), joint inventor Mr. Ekhaus apparently refuses to declare that he has "reviewed and understands the contents" of the above-identified application "including the claims" as required by 37 C.F.R. § 1.63(b)(2) because he allegedly believes he "has not had the opportunity to fully review the application to the decree [sic] that makes him comfortable with what is contained therein" (see Exhibit P: a copy of the March 12, 2002 facsimile from Mr. Schumann on behalf of Mr. Ekhaus).

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Application No. 09/887,528

**THE COMMISSIONER SHOULD ACCEPT THE ENCLOSED DECLARATIONS
EXECUTED BY ROBERT DRISKILL AND FILIP MULIER AS PROPER AND
ALLOW PROSECUTION TO BEGIN ON THE ABOVE IDENTIFIED
APPLICATION**

- A. The Declarations Signed by Robert Driskill and Filip Mulier May be Treated as Having Been Signed by All of the Joint Inventors on behalf of the non-signing inventor

According to 37 C.F.R. 1.47(a), if a joint inventor refuses to join in an application for patent, an application may be made by an available inventor on behalf of himself or herself and the nonsigning inventor. According to M.P.E.P. § 409.03(a)(A), a declaration signed by all of the available joint inventors with the signature block of the nonsigning inventors left blank may be treated as having been signed by all of the available inventors on behalf of the nonsigning inventor.

Accompanying this Petition is a Declaration signed by available joint inventor Robert Driskill on December 23, 2001 (Exhibit K) and a Declaration signed by available joint inventor Filip Mulier on January 8, 2002 (Exhibit J). On both executed Declarations, the signature block for Michael A. Ekhaus, who refuses to join, has been left blank. Accordingly, Applicants submit that the requirements of M.P.E.P. § 409.03(a)(A) have been met.

- B. A copy of the application, as it was filed on June 25, 2001, was sent to joint inventor Michael A. Ekhaus' last known address on September 27, 2001

According to M.P.E.P. § 409.03(d), a copy of the application papers should be sent to the last known address of the nonsigning inventor. As indicated above in the Statement of Facts, item II, the undersigned sent a copy of the application and figures to the last known address of nonsigning joint inventor Michael A. Ekhaus.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Application No. 09/887,528

C. The Last Known Address for Michael A. Ekhaus

Pursuant to 37 C.F.R. § 1.47(a) and M.P.E.P. §§ 409.03(a)(C) and 409.03(e), the last known addresses for the nonsigning inventor is:

Mr. Michael A. Ekhaus
315 Washington Avenue
Hopkins, MN 55343

Furthermore, pursuant to M.P.E.P. § 409.03(e), the address for counsel to joint inventor Mr. Ekhaus, and known to the undersigned is:

Mr. Michael A. Ekhaus
c/o Glen E. Schumann, Esq.
Moss & Barnett
4800 Wells Fargo Center
Minneapolis, MN 55402-4129

D. Discussion of the Statement of Facts and the Documentary Evidence as it relates to Mr. Ekhaus' Refusal to Join in accordance with M.P.E.P. § 409.03(d)

Refusal to join by joint inventor Mr. Ekhaus was made to the undersigned both through his counsel, Mr. Schumann, and by submitting the executed "Declaration" included in Exhibit S.

Firstly, as recited above in the Statement of Facts, item XV, the undersigned indicated to Mr. Schumann, counsel for joint inventor Mr. Ekhaus, that language stating that Mr. Ekhaus has "reviewed and understands the content of the application, including the claims" is required in a Declaration complying with the Statute and the Rules (see, for example, 37 C.F.R. § 1.63(b)(2)).

In addition, as recited in the Statement of Facts, item XV, the undersigned indicated to Mr. Schumann that language stating that Mr. Ekhaus believes himself to be the "original, first" joint inventor is also required in a Declaration complying with the Statute and the Rules (see, for

Application No. 09/887,528

example, 35 U.S.C § 115).

With respect to both of the above aspects of an acceptable Declaration, Mr. Ekhaus, in consultation with registered patent attorney Mr. Schumann, struck out the required language in the executed version of the "Declaration." (See Exhibit S.) Further still, the documentary evidence suggests that joint inventor Mr. Ekhaus implemented his alterations to the Declaration with the knowledge that the Assignee would proceed in accordance with the present petition under 37 C.F.R. § 1.47(a). (See, for example, the undersigned's March 8, 2002 e-mail (Exhibit O) and the undersigned's March 13, 2002 e-mail (Exhibit R) and facsimile (Exhibit Q) indicating that the Assignee would proceed in accordance with 37 C.F.R. § 1.47 if Mr. Ekhaus refused to execute a Declaration in compliance with the Statute and the Rules.)

Accordingly, and pursuant to M.P.E.P. § 409.03(d), the undersigned submits that: (i) Refusal to Join by joint inventor Michael A. Ekhaus was made to the undersigned; (ii) the undersigned has submitted a Statement of Facts specifying the circumstances of the presentation of the application papers and the Refusal; (iii) documentary evidence supporting the Statement of Facts has been submitted; and (iv) the nonsigning inventor's reasons for refusing to sign have been submitted.

CONCLUSION

The undersigned submits that all the requirements of 37 C.F.R. § 1.47(a) and M.P.E.P. §§ 409.03(a) (A)-(C), 409.03(d), and 409.03(e) have been met. In summary, the Applicants have submitted: (i) a statement of facts describing the presentation of the application papers and the

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Application No. 09/887,528

subsequent refusal to join by joint inventor Michael A. Ekhaus correlated with documentary evidence to support the statement of facts; (ii) the reasons provided by joint inventor Michael A. Ekhaus for refusing to sign the declaration; (iii) Declarations signed by the available inventors; and (iv) the last known address for each nonsigning inventor.

Accordingly, the undersigned requests that the Commissioner approve this petition and the enclosed Declarations executed by Robert Driskill and Filip Mulier, and allow prosecution on the merits to begin on the above-identified application.

The required petition fee set forth under 37 C.F.R. § 1.17(h) is enclosed. If there are any other fees required for filing this response, including any fees for extensions of time required to enter this response, please charge these fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: 

James J. Boyle
Reg. No. 46,570

Dated: March 18, 2002

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com